

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Gregg D. Wilensky	Art Unit :	2624
Patent No. :	7,412,105	Examiner :	Jeffrey S. Smith
Issue Date :	August 12, 2008	Conf. No. :	4008
Serial No. :	10/678,366		
Filed :	October 3, 2003		
Title :	TONE SELECTIVE ADJUSTMENT OF IMAGES		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Issue Notification mailed July 23, 2008 for the above-referenced application indicates that the Patent Term Adjustment at issuance is 717 days. Reconsideration of the Patent Term Adjustment calculation to increase PTO Delay from 740 days to 1012 days, and to increase Total PTA from 717 to 989 days, is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a delayed 14-month first non-final Office Action on December 13, 2006, thereby according a PTO Delay of 740 days. Applicant does not dispute herein this patent term adjustment calculation for this PTO "A Delay."
- 2) Applicant filed a late response to the first non-final Office Action on April 5, 2007 (received at the PTO on April 5, 2007). Applicant was accorded a delay of 23 days for a supplemental response. Applicant does not dispute herein this patent term adjustment for Applicant Delay.
- 3) The application was filed on October 3, 2003 and the patent issued on August 12, 2008, more than three years later. The earliest Request for Continued

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS -WEB system on this date: December 22, 2008

Examination was filed on September 11, 2007. No PTO Delay was calculated for issuance of the patent after three years from filing. Applicant respectfully submits that the PTO's calculation of this PTO "B Delay" contains an error and that the correct PTO Delay for issuance beyond three years from filing is 272 days, as outlined further below. The PTO Delay of 740 days ("A Delay") includes 71 days after three years from filing where "A" and "B" delays overlap. Therefore, the "B Delay" of 272 days does not include the overlapping 71 days.

REMARKS

Applicant has calculated the PTA in accordance with the clear intent of Congress. As outlined in *Wyeth v. Dudas* (*Wyeth et al. v. Jon W. Dudas*, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that periods of time can "overlap" is if they occur on the same day, and if an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. "A Delays" are defined as delays by the Office under 35 U.S.C. 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than 3-year application pendency.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, relies on the premise that the application was delayed under § 154(b)(1)(B) before the initial three-year period expired.

The *Wyeth* court determined that this construction cannot be squared with the language of § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years," and that "B delay" begins once the PTO has failed to issue a patent within three years, not before.

In the current PTA calculation, the Office has only given credit for the larger of "A Delay" or "B Delay," rather than the combined sum of "A Delay" and "B Delay" (which does not include any days after three years from filing where "A" and "B" delays overlap).

In this patent, "A Delay" should be calculated as 740 days, and "B Delay" should be calculated as 272 days. Thus, the total PTO Delay should be calculated as 1012 days.

In consideration of the events described above, Applicant believes the PTA calculation of 717 days is incorrect. As such, Applicant respectfully requests reconsideration of the patent term adjustment in the following manner:

- 1) Total PTO Delay should be calculated as 1012 days;
- 2) Total Applicant Delay should be calculated as 23 days; and
- 3) Total PTA should be calculated as 989 days.

Applicant notes that this patent is not subject to a terminal disclaimer.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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